

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

I. Introduction

Claims 3-20 and 49-60 are pending in this application. Claim 3 has been amended. New claims 57-60 have been added. Support for the amendment to claim 3 may be found in paragraph [0035]. Support for claims 57-60 may be found, for example, in paragraphs [0053] and [0055]. No new matter was added.

II. § 102(b) Rejection Should Be Withdrawn

Claim 3 has been rejected as being anticipated by Charlton. This rejection is respectfully traversed.

Claim 3 has been amended to recite that the first means is a means for supporting a photovoltaic cell inside a window¹ in a building façade envelope. Since claim 3 is written in means plus function format of 35 USC 112 paragraph 6, the recited function has to be given patentable weight. In other words, in order to render anticipate claim 3, the applied prior art would have to explicitly teach a means for supporting a photovoltaic cell inside a window in a building façade envelope.²

¹ The term window, as used herein, means a transparent part of the building façade which admits light into the interior spaces of the building. As is apparent to one of ordinary skill in the art, the term window includes both windows which can be opened to allow air into the interior of the building and windows which cannot be opened, such as windows in many modern office buildings.

² In order to establish a *prima facie* case of unpatentability of a claim containing a section 112 paragraph 6 means plus function element, the examiner must find a prior art element that actually performs the claimed function; it is not enough that the prior art's structure is capable of performing the claimed function when the prior art specifically

In contrast, the building blocks of Charlton are not formed in a window in a building façade. The building blocks of Charlton are formed in a wall of the building façade (see col. 2, lines 19-28 and col. 4, lines 33-41 of Charlton). Charlton does not teach or suggest forming the building blocks in windows. Thus, Charlton does not anticipate claim 3.

Furthermore, it appears that the building blocks of Charlton are not suitable to be placed in windows. The back side of each rectangular building block contains thermal insulation 26 which retains heat within the building block (col. 4, lines 7-11 of Charlton). Thus, it appears that the thermal insulation 26 is not transparent to light. Therefore, the building block of Charlton is not suitable for placement in a window because the thermal insulation would block the light from entering the window.

In contrast, as shown in Figures 9A-9D of the present application, the modules of claim 3 are suitable for placement in a window because of their configuration.

III. § 103(a) Rejection Should Be Withdrawn

Claims 3-6, 8-12, 14, 15, 49, 50-53, 55 and 56 have been rejected as being obvious over Barone in view of Charlton. Claims 7, 13, 16-20 and 54 have been rejected as being obvious over Barone in view of Charlton and further in view of Kaminar. These rejections are respectively traversed.

teaches against performing such a function. See MPEP 2183. For example, the predecessor court to the Federal Circuit stated:

We cannot agree with the board that the [means plus function] claims “merely recite ‘a means’.” They recite a means plus a function which is not to be found in Leutwyler [the prior art reference]. They therefore do not read on that reference and are not anticipated thereby.

In re Mott, 194 USPQ 305, 307 (CCPA 1977). The Federal Circuit cited *In re Mott* with approval in *RCA Corp. v. Applied Digital Data Systems, Inc.*, 221 USPQ 385 (Fed. Cir. 1984). On page 389, footnote 5, the court stated

The claims here define the invention in terms of specific “means-plus-function” elements. The limitations which must be met by an anticipatory reference are those set forth in each statement of function. In *re Mott*, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977). Such a limitation cannot be met by an element in a reference that performs a different function, even though it may be part of a device embodying the same general overall concept. [Emphasis added].

1. Claims 9 and 53

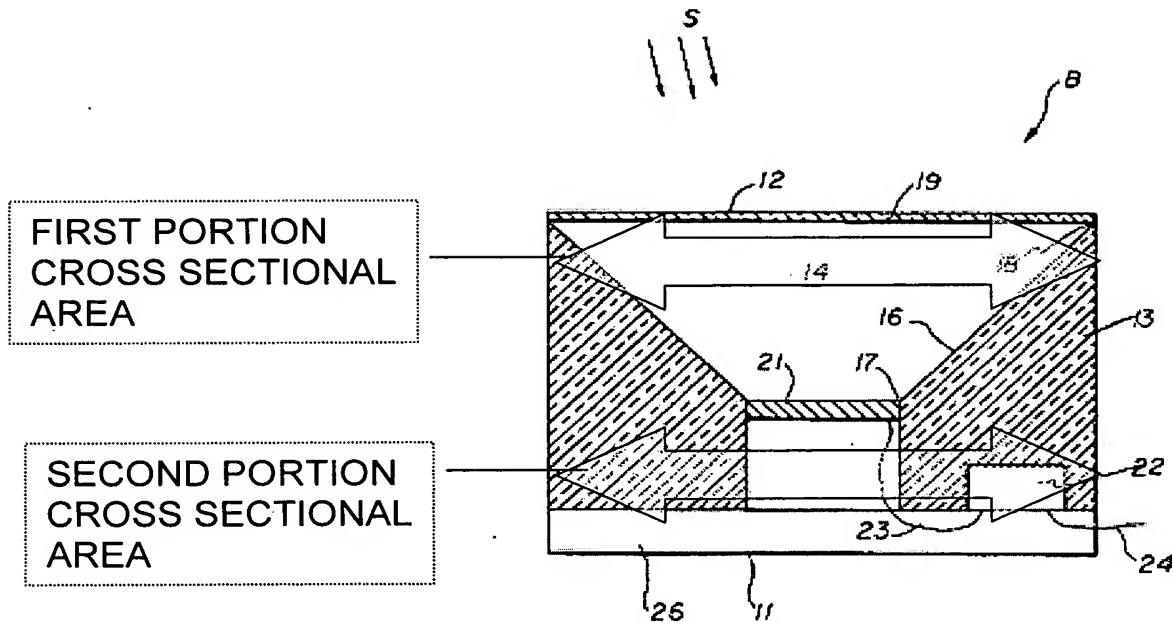
Independent claims 9 and 53 were each rejected over a combination of Barone and Charlton. However, even if there was motivation to combine these two references, the combination still would not teach every limitation of these claims.

Claims 9 and 53 each recite that “the first portion of the back support structure has a first cross sectional area and a second portion of the back support structure has a second cross sectional area smaller than the first area”. Thus, the entire cross sectional area in one part of the back support structure is smaller than the cross sectional area in another part of the back support structure.

For example, as shown in Figures 4A-4F of the present application, the back support structure is conical or pyramidal with a smaller cross sectional area in the back than in the front. This configuration allows the module to be placed in the window without blocking the entire window and allows the module to be pivoted between the window panes to follow the Sun.

In contrast, the body 13 of Charlton corresponds to the back support structure of the building block of Charlton. The body 13 is rectangular in shape because it is supposed to approximate a brick and has the same cross sectional area throughout its height.

Thus, as shown by arrows in the overlay of Figure 5 of Charlton on the next page, the upper portion of the back support structure 13 has the same cross sectional area as the lower portion of the back support structure. Only the recess 14 in the back support structure 13 of Charlton has a conical shape. However, claims 9 and 53 recite that the portions of the back support structure itself, and not necessarily the portions in the recess in the back support structure, have a different cross sectional area. Thus, Charlton does not teach this limitation of claims 9 and 53.



Barone does not remedy the deficiency of Charlton because Barone also does not teach or suggest that different portions of the back support structure have a different cross sectional area. Furthermore, there is no motivation to modify the building block of Charlton to form different portions of the back support structure (i.e., body 13) to have different cross sectional areas because it would make body 13 to have a non-brick shape. The non-brick shape would make the body of Charlton less suitable to comprise a portion of a building wall, as required by Charlton. Thus, such a modification would make the body 13 of Charlton unsatisfactory for its intended purpose. According to MPEP 2143.01(V), if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Furthermore, claim 53 recites that the back support structure itself has a substantially pyramidal or a substantially conical shape. In contrast, a recess 14 in the body 13 of Charlton has a pyramidal shape. The body 13 itself of Charlton does not have a pyramidal shape. The

body 13 of Charlton is rectangular in shape in cross sections shown in Figures 3 and 4 of Charlton (it is a brick-shaped hexahedron with six rectangular faces in three dimensions).

2. Claims 57-60

New claims 57-60 have been added to recite that the module is adapted to track the Sun. In contrast, the building blocks of Charlton are stationary and do not track the Sun. Furthermore, Barone teaches away from a solar cell system which moves to track the Sun because it is complex and costly (see col. 1, lines 30-42 of Barone). The system of Barone relies on a stationary lens array 2 to track the Sun instead. Therefore, even if there was motivation to combine Barone and Charlton, there is no motivation to modify the combined system of Barone and Charlton to track the Sun because Barone teaches away from this feature.

IV. Conclusion

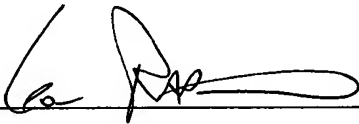
Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or

even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 12/30/05

By 

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